

## Well Known Marks

*Anjali Shekhawat, 4th Year, B.A.LL.B, Rajiv Gandhi National University of law, Punjab*

### Abstract

Identification/Representation is the key to human life. A child learns by identifying objects and association that with sounds/actions/images. The subject of Trademarks thrives on a similar idea. People relate to services/commodities with logos/marks/images presented by the proprietors to represent their business. The fundamental principle of trademark protection has been to safeguard the rights of extensive and established user of a mark who represents his business by that mark, so as not to cause him any harm due to deceptiveness by others. So the basic thing would be that once a mark is taken up for business by one it should not be used by another but obviously the matters in real world are not that easily decided. To achieve simplicity in this area, the idea of prior use, well known mark, goodwill, etc. have been introduced in trademarks law. Once a mark is declared well-known; no other can copy it or adopt a deceptively similar mark in any of the class of goods or services.

The Trademarks Act have been framed and incorporated to safeguard these proprietor against any undue advantage by someone else and to protect the people from getting tricked into getting/availing something of inadequate quality. The Trademarks Act, 1999 defines well known mark as; “*well-known trade mark, in relation to any goods or services, means a mark which has become so to the substantial segment of the public which uses such goods or receives such services that the use of such mark in relation to other goods or services would be likely to be taken as indicating a connection in the course of trade or rendering of services between those goods or services and a person using the mark in relation to the first-mentioned goods or services.*”<sup>1</sup> Well known marks would be the marks which are used in course of business by a certain proprietor and have gained popularity, whereby people now associate the mark with that particular proprietor. Thus, well known marks are associated with a certain brand and given protection to safeguard the interest of an established business, popular among general public for its goods or services. It ensures that the innocent people don’t get misled by fraudulent traders taking advantage of goodwill reputation of others. The question that arises in any mind is how to determine such marks. Under the Trademarks Act, for a mark to be well known certain criteria has to be fulfilled;

- The mark should be popular among general people and in use for a substantial amount of time
- If similar or resembling mark was used by another, it should be likely to deceive the public
- The mark is associated with the proprietor and recognised by people to be so, regardless of the registration or application of trademark

Trademarks act 1999 has provided the well-known mark protection against use by another regardless of its registration, registration in India, any such application, its use in Indian market or its knowledge in Indian market. The determination of such well-known marks was done by registrars in opposition proceeding or courts in infringements proceedings after hearing the arguments and establishing the surrounding circumstances. In the year 2017, the Trademark Rules 2017 was introduced and under its Rule 124, it was made possible for a proprietor to get his trademark to be registered as well known, i.e., to have complete autonomy over the mark even in

---

<sup>1</sup> The Trademarks Act, 1999, S (2) (1)(zg).

regards with other classes of business, without any proceeding rather with direct registration. The proprietor has to file for registration of his mark as well-known mark, pay a fee of Rs. One Lakh with adequate evidence as required and the Registrar will publish it in journal for any opposition to be raised within thirty days. If the mark is not opposed, the mark would be declared well known. This development is indeed astounding and makes the trademark registration process a lot more convenient by laying out the possibility of registration of marks having well established reputation & goodwill. The pile up of multiple application, rectification proceedings, etc. can be simply avoided. There is no doubt that the protection to well-known marks must be granted to fulfil the primary objectives of trademarks legislation. Although, making the registration that simple could harm the unaware proprietors and also ignores the right to trial.

Before this development, Courts and Registrars dealt with such cases through proceedings to determine the popularity of mark and its distinctiveness. A strict approach was adopted by Hon'ble High Court of Delhi in *Daimler Benz Aktiengesellschaft and Ors. Vs. Hybo Hindustan*, MANU/DE/0035/1994, while dealing with a case where defendant copied the device mark and work mark of the plaintiff in course of its business of selling underwear. The court held that, "*None should be continued to be allowed to use a world famed name to goods which have no connection with the type of goods which have generated the worldwide reputation....In my view, destruction of the underwears, or non-use of the said goods should send a clear, message to persons, at least of the eminence, of Hybo Hindustan, that they should not demean other people's name and reputation by using the name like "Benz" with reference to the goods produced by them.*" The court laid out that no one should try to illegitimately use a well-known mark and a clear message is sent out for whosoever does, by destroying the merchandise.

Similarly in the cases *Toyota Jidosha Kabushiki Kaisha vs. Deepak Mangal and Ors.*, MANU/DE/1602/2016, *Milmet Oftho Industries & Ors. v. Allergan Inc.*, MANU/SC/0512/2004 and *N.R. Dongre v. Whirlpool Corporation*, MANU/SC/1223/1996, the court on similar principles said "*Even advertisement of trademark without existence of goods in the market is also to be considered as use of the trademark. It is also not necessary however that the association of the plaintiff's marks with his goods should be known all over the country or to every person in the area where it is known best.*" The courts examined all the surrounding circumstances, heard the other party, weighed such consideration in the light of general market and then came to a conclusion

that a mark is well known. The introduction of Rule 124, Trademarks Rule 2017 has made the process of identification as well-known mark a bit easier. Now a proprietor can directly approach the trademark registry as per Rule 124, fill the TM-M form, and follow the procedure to get his mark engraved in the list of well-known mark, which would never be misused by another in any class of business. The fees demanded and evidence required has made it sure that only genuine proprietors dare to claim such right and do not destroy the integrity of registry.

Though, The question that arises now is that adequate remedy if the facts that were before thoroughly examined by the court and registry through trials and opposition with adequate platform for people to be heard; could now be considered only in light of evidences and 30 day time period in the journal. The unaware and underprivileged proprietors who were allowed to use marks for being 'honest and concurrent use' in a particular territory; could they not face substantial harm as a result of this. No doubt there are other remedies in the Act and rules but such a vague definition/parameters for a well-known mark could lead to grave misuse and breach of integrity of registry. To declare marks, which are not even known to a substantial group of people in an area, would actually contradict the concept of 'Well-known'. What exactly would be the parameters of well-known if they don't exclusively include the knowledge of mark among the vast section of people. Judgements scrutinized the background, surrounding circumstances, crowd, the other proprietor's situation & intention, marks wholeness, distinctness, knowledge, etc. Are the statutory provisions enough to replace that? Or Is rule 124 adequate? Does this confer discretionary power to the registrar? Some marks are known to every bit of community, too engraved images and reputation, shouldn't these marks alone be considered well-known in case where there's a direct application. Could this defeat the purpose of the act if misled in ways? These are the questions that arises in ones' mind and the need for further clarity in the rules is highlighted. The courts through judgements have made these clarifications and same should be adopted in the legislation as well. India is evolving, so are the laws and such development is extremely crucial for the country.